II. Rejection under § 103(a)

In this Office Action, the Examiner rejects all pending claims as obvious under 35 U.S.C. § 103(a) over EP 838 11. In response, Applicants assert that the Examiner has failed to make out a prima facie case of obviousness as required by law and therefore respectfully request withdrawal of the obviousness rejection.

According to the Examiner, EP 838 211 discloses hair mousse compositions containing polyurethane resins which may be delivered via an aerosol dispenser containing propellant. (Office Action at 2.) The Examiner also asserts that the compositions may optionally contain "additional cosmetic ingredients," and that the "amount of polyurethane claimed overlaps with that disclosed by EP [838 211].". (Office Action at 2-3). The Examiner goes on to conclude that "Applicant's claims are directed towards similar hair mousse compositions containing the ingredients disclosed by EP," but concedes that "EP lacks a specific disclosure of the flow rate claimed or the nozzle orifice dimensions of the aerosol delivery device." (Office Action at 3). The Examiner believed that these components could be supplied by "routine skill in the art." (Office Action at 3).

Applicants respectfully submit that the Examiner has overstated the teachings of the cited reference and misinterpreted the claims of the present invention in the Office Action. For example, contrary to the Examiner's assertion, the claims of the present application are directed to an aerosol device, not a "hair mousse composition." Furthermore, Applicants assert that the Examiner's statements, even if taken at face value, fail to establish a proper prima facie case of obviousness.

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In order to establish a prima facie case of obviousness, an Examiner must establish that the prior art relied upon, when coupled with the knowledge generally available to one of skill in the art at the time of the invention, must contain some suggestion or incentive that would have motivated the skilled artisan to modify a reference or combine references. *See In re Fine*, 837 F.2d 1071, 1074 (Fed. Cir. 1988). The Examiner must also establish that the prior art reference or combination of references must teach or suggest to one of skill in the art all the limitations of the claims. *See In re Wilson*, 424 F.2d 1382, 1385 (C.C.P.A. 1970). Because the Examiner has failed to meet at least these requirements, he has not established a proper *prima facie* case of obviousness, as required by law.

First, the Examiner has failed to show that EP 838 211 teaches or suggests to one of skill in the art all the limitations of the claims. The Examiner admits in the Office Action admits that the reference does not teach "the flow rate claimed or the nozzle orifice dimensions of the aerosol delivery device." (Office Action at 3). Furthermore, the reference nowhere discloses that the weight ratio of the propellant to the organic solvent is greater than or equal to 1.5:1. Additionally, with respect to claims 28 and 29, the reference nowhere discloses that the polycondensate is formed from an arrangement of blocks obtained from the three types of compounds listed. Moreover, Applicants do not believe that the reference suggests any of these missing elements, nor has the Examiner even pointed to any such suggestion in the reference. The Examiner therefore has not established that the reference cited teaches or suggests to one of skill in the art all the limitations of the claims, as required by law.

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The Examiner attempts to overcome the deficiencies in the disclosure of the reference by claiming that one of skill in the art could rely on "routine skill" to arrive at the claimed flow rate, the claimed ratio of propellant to organic solvent, and, with respect to claims 29 and 29, the claimed composition of the polycondensate. However, providing the missing elements which are lacking from the reference is not a matter of routine skill or mere optimization; the Examiner must set forth a rationale for making such modifications.

In the present case, the Examiner has not established that one of skill in the art would be motivated by the cited reference to conduct such an optimization. Instead, the Examiner has relied upon unsupported conclusory statements in an attempt to fabricate the requisite motivation. As noted above, one of the requirements of a prima facie case of obviousness is that the reference must contain some suggestion that would motivate one of skill in the art to modify the reference to arrive at the present invention. The Examiner has not set forth how the cited reference in any way would motivate one of skill in the art to modify its disclosed hair mousse composition to arrive at the claimed aerosol device.

Finally, Applicants disagree with the Examiner statement that the synthesis of the claimed polycondensate "is not relevant from a patentability point of view." (Office Action at 3).[1] Rather, Applicants submit that each and every element of the claim must be considered by the Examiner, and can not simply be dismissed as irrelevant to the

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[1] Applicants presume the Examiner is referring to claims 28 and 29, which recite that the "at least one polycondensate is formed from an arrangement of blocks, this arrangement being obtained from" the three types of compounds listed in the claims.

patentability of the claim. Moreover, there exists no statutory basis that allows the Examiner to summarily dismiss claim elements.

Applicants respectfully submit that the Examiner's conclusion of obviousness is legally incorrect and therefore should be withdrawn. Applicants request the reconsideration of the pending claims and the timely allowance of the present application.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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Dated: June 27, 2002

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